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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,128	04/04/2006	James J. Collins	0079571-0094	3605
24280 7590 06/10/2008 CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110				
EXAMINER SULLIVAN, DANIEL M				
ART UNIT		PAPER NUMBER		
1636				
NOTIFICATION DATE		DELIVERY MODE		
06/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@choate.com

Office Action Summary

Application No.

10/535,128

Applicant(s)

COLLINS ET AL.

Examiner

Daniel M. Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: ____.

Continuation of Disposition of Claims: Claims pending in the application are 1-7, 15, 17, 19, 24, 25, 28, 29, 36, 41, 42, 45, 46, 49, 50, 52-54, 57-59, 62, 68, 72, 74, 82, 86, 90, 94, 95, 116 and 177-211.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-7, 15, 17, 19, 24, 25, 28, 29, 36, 41, 42, 45, 46, 49, 50, 52-54, 57-59, 62, 68, 72, 74, 82, 86, 90, 94, 95, 116 and 177-211.

DETAILED ACTION

Claims 1-7, 15, 17, 19, 24, 25, 28, 29, 36, 41, 42, 45, 46, 49, 50, 52-54, 57-59, 62, 68, 72, 74, 82, 86, 90, 94, 95, 116 and 177-211 are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, 15, 17, 19, 24, 25, 28, 29, 36, 41, 45, 62, 68, 72, 74, 82, 86 and 90, drawn to a nucleic acid molecule comprising a first and second stem-forming portion and a non-stem-forming portion connecting the first and second stem forming portions, wherein a portion of the nucleic acid molecule complementary to the nucleic acid molecule.

Group II, claim(s) 42, 46, 49, 50, 52-54, 57-59, 94 and 95, drawn to construct that contains a template for the nucleic acid molecule of Group I.

Group III, claim(s) 116 and 177-180, drawn to a combination comprising a first nucleic acid molecule comprising a cis-repressive sequence and a second nucleic acid molecule comprising complementarity to a portion of the first nucleic acid molecule and capable of interacting with the first nucleic acid molecule to derepress translation.

Group IV, claim(s) 181-186, 210 and 211, drawn to a method of regulating translation of an open reading frame using the nucleic acid molecule of Group I or the combination of Group III.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

37 CFR 1.475(b) states:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically adapted for the manufacture of the said product; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.”

Furthermore, according to PCT Rule 13.2, unity of invention exists only when there is a shared same or corresponding special technical feature among the claimed inventions. The “Instructions Concerning Unity of Invention” (MPEP, Administrative Instructions Under the PCT, Annex B, Part 1(b)) state, “The expression ‘special technical features’ is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art.” Thus, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the art.

In the instant case, the technical feature common to the inventions is the nucleic acid molecule of Group I. However, Inouye et al. US Patent No. 5,272,065 teaches a nucleic acid molecule comprising all of the elements of the Group I nucleic acid molecule. (See especially Figure 3 and the caption thereto.) Therefore, the nucleic acid molecule of Group I does not define a unifying special technical feature. Furthermore, the invention of Group II requires that the nucleic acid molecule be a template for the nucleic acid molecule of Group I, which defines a special technical feature not shared by the Group I nucleic acid or group II combination. Group III is directed to a combination of elements that is not required by the inventions of Groups I or II and, given that the Group I nucleic acid is not a contribution over the art and the combination does not require the Group II nucleic acid, there is no special technical feature that unites the groups. Likewise, as the elements used in the method of Group IV are not a contribution over the art, there is no special technical feature linking the products with the method.

Accordingly, Groups I-IV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept. Therefore, restriction under 35 U.S.C. 121 and 372 is proper.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The nucleic acid molecule of Group I, wherein the nucleic acid molecule has the sequence of crR10, crR12, a variant of crR10, a variant of crR12, taR10, taR12, a variant of taR10, or a variant of taR12. Applicant must elect a single sequence or variant for initial prosecution.

The combination of Group III, wherein the kit comprises one element or a single combination of elements as set forth in part (c) of claim 177.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1 or 62 are generic to the species of Group I. No claims are generic to the species of Group III.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each species requires a unique sequence that defines a special technical feature that is not shared by the other identified species.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M. Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Friday 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach, Ph.D. can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel M Sullivan/
Primary Examiner, Art Unit 1636